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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/054,538 | 10/25/2001 | Brian Robert Simpson | CAF-19103/03 | 7183 |

7590 06/04/2003

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| EXAMINER |
|---|
| TARAZANO, DONALD LAWRENCE |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1773 | |

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/054,538 | SIMPSON ET AL. | |
| | Examiner | Art Unit | |
| | D. Lawrence Tarazano | 1773 | |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondenc address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☒ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *08/703,028* .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,287,706. Although the conflicting claims are not identical, they are not patentably distinct from each other because the films claimed here are a component of flooring and the prior patent is directed to multilayer flooring in which the additional layers rectied are those which are conventionally used in the fomation of vinyl flooring.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-7, 10 and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Betso et al. (5,576,374).

5. Betso et al. teach a blend of substantially linear ethylene / alpha olefin copolymer, a second olefin polymer, and filler. The substantially linear ethylene / alpha-olefin copolymer is made by Dow's constrained geometry catalyst system (column 4, lines 45-57). This corresponds to the materials used by applicants. Betso et al. teach that these materials are extruded (column 9, lines 49+) and recite, "single ply roofing" as one of the forms. While the applicants claim the instant materials as being flooring. The examiner takes the position that the single ply roofing material taught by the prior art corresponds to the claimed sheet material. The material of the prior art has the capability of functioning as a polymeric floor covering and therefore meets the applicants' intended us of the material. Regarding the processing conditions, the materials are compounded at temperatures above 75 deg C as claimed and can be extruded and formed into sheets (single ply roofing). It is understood to those having ordinary skill in the art that the extrusion of the polymer mixture would occur at elevated temperatures and that the formed sheet would be hot when it comes out of the extruder and then would cool. It would be very difficult if

not impossible to form a sheet out of the compositon without melting the composition and then cooling it after the sheet was formed.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-7, 10-16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (5,366,779) in view of Lai et al. (5,272,236).

8. Thompson teaches flooring materials, which comprise fillers, tar, and polyethylene (claims 1 and 2). The tar material would function as a plasticizer. However, while Thompson generally suggests the use of polyethylene materials, there is no specific mention of narrow molecular weight polyethylene materials made by single site catalysis or the use of foamed layers.

9. Lai et al. teach narrow molecular weight, substantially linear, single site catalyzed ethylene / alpha olefin copolymers (polyethylene) which have improved processability and Dart impact strength over conventional polyethylene (see column 2, lines 11-50, and column 21).

10. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the polyethylene materials produced by Lai et al. for use in the flooring taught by Thompson et al. in order to produce materials having improved processability and Dart impact strength.

11. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included a calendaring step in the formation of the sheets taught by Thompson et al. in order to produce more even smoother coating.

12. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Betso et al. (5,576,374).

13. Betso et al. are silent regarding the processing condition used to make extruded structures (column 9, lines 38-53); however, the materials are compounded at a temperature above 75 deg C as claimed. Regarding the limitation that the compounding / melting point is done without degradation of the mixture, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have chosen the processing temperature such that the polymers did not degrade since degrading the polymers during processing would produce a product with inferior / degraded properties.

Regarding the limitation that the mixture is formed into a sheet and then allowed to cool. Betso et al. teach that the sheet structures such as roofing membranes are produced and teach that extrusion may be use to form articles. The examiner takes the position that following the formation of sheets by extrusion of hot polymer blend, the sheet would cool as claimed.

The polymer compositon may contain processing additives such as anti-block additives.

*Conclusion*

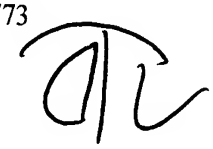
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The examiner cites Simpson et al. (6,337,126).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (703)-308-2379. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on (703)-309-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.

D. Lawrence Tarazano
Primary Examiner
Art Unit 1773



dlt
May 30, 2003